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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte BRIAN L. JACKSON and CRAIG E. BINGHAM

Appeal 2008-003068
Application 10/033,943
Technology Center 3600

Decided:¹ July 20, 2009

Before ALLEN R. MACDONALD, Vice Chief Administrative Patent Judge,
and ANTON W. FETTING, and BIBHU R. MOHANTY, Administrative
Patent Judges.

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

1 STATEMENT OF THE CASE

2 Brian L. Jackson and Craig E. Bingham (Appellants) seek review
3 under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-41, the only
4 claims pending in the application on appeal.

5 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
6 (2002).

7

8 SUMMARY OF DECISION²

9 We REVERSE.

10

11 THE INVENTION

12 The Appellants invented a way of natural gas distribution compliance
13 management by maintaining a database identifying compliance events and
14 resources (Specification 5:2-6).

15 An understanding of the invention can be derived from a reading of
16 exemplary claim 1, which is reproduced below [bracketed matter and some
17 paragraphing added].

18 1. A computerized method for natural gas distribution
19 compliance management, comprising:
20 [1] maintaining a database identifying
21 a plurality of compliance events and
22 a plurality of resources;
23 [2] providing a computer system including
24 a main computer and
25 a remote computer adapted to communicate with
26 the main computer,

² Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed February 20, 2007) and Reply Brief ("Reply Br.," filed August 29, 2007), and the Examiner's Answer ("Ans.," mailed November 2, 2007).

1 at least a portion of a main program and the database
2 accessible by the main computer,
3 the remote computer accessing a remote program
4 operative to display and modify
5 only a remote portion of the plurality of
6 compliance events and
7 only a remote portion of the plurality of resources
8 of the database;
9 [3] periodically scanning the database to identify at least one of
10 the plurality of compliance events requiring a response;
11 [4] scanning the database to identify at least one of the plurality
12 of resources to respond to the compliance event requiring the
13 response;
14 [5] matching at least one of the plurality of resources with the
15 compliance event requiring the response; and
16 [6] scheduling the resource to respond to the compliance event.
17

18 THE REJECTIONS

19 The Examiner relies upon the following prior art:

20 Sturgeon US 5,726,884 Mar. 10, 1998

21 Securities and Exchange Commission, Santa Fe Pacific Corporation
22 Annual Report (1992) (hereinafter “Santa Fe”).

23 Claims 1-6, 24-28, and 38-41 stand rejected under 35 U.S.C. § 102(b)
24 as anticipated by Sturgeon.

25 Claims 7-23 and 29-37 stand rejected under 35 U.S.C. § 103(a) as
26 unpatentable over Sturgeon and Santa Fe.

27 ARGUMENTS

28 The Appellants argue independent claims 1, 24, 28, and 38 as a group.
29 App. Br. 17. The Appellants rely on these arguments in support of the
30 dependent claims for both the rejections under anticipation and obviousness.

1 Thus, we treat all claims as argued as a group and select claim 1 as
2 representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

3 The Appellants contend that Sturgeon fails to describe the claim
4 limitations of the remote computer accessing a remote program operative to
5 display and modify only a remote portion of the plurality of compliance
6 events and only a remote portion of the plurality of resources of the database
7 in limitation [2] and scheduling the resource to respond to the compliance
8 event in limitation [6]. App. Br. 18-19.

9 The Examiner found that Sturgeon described the remote computer
10 limitation at Sturgeon 10:39-60 (Ans. 3) and 23:60 – 24:40 (Ans. 10) and the
11 scheduling at Sturgeon 32:27-44 (Ans. 4).

12

13 ISSUES

14 The issue of whether the Appellants have sustained their burden of
15 showing that the Examiner erred in rejecting claims 1-6, 24-28, and 38-41
16 under 35 U.S.C. § 102(b) as anticipated by Sturgeon turns on whether
17 Sturgeon describes the remote computer and its operations recited in claim 1
18 limitation [2].

19 The issue of whether the Appellants have sustained their burden of
20 showing that the Examiner erred in rejecting claims 7-23 and 29-37 under 35
21 U.S.C. § 103(a) as unpatentable over Sturgeon and Santa Fe turns on
22 whether the Examiner has shown that Sturgeon suggests the remote
23 computer and its operations recited in claim 1 limitation [2].

24

1 FACTS PERTINENT TO THE ISSUES

2 The following enumerated Findings of Fact (FF) are believed to be
3 supported by a preponderance of the evidence.

4 *Facts Related to the Prior Art*

5 *Sturgeon*

6 01. Sturgeon is directed to sharing or exchanging information on
7 hazardous substances for in-house and regulatory compliance-
8 related functions using eight functional groupings and a relational
9 database schema or database design that integrates these
10 functional groupings. Sturgeon 9:32-38.

11 02. Sturgeon describes a Hazardous Commitment Management
12 ("HCM") functional grouping that provides for management of
13 data relevant to hazardous materials-related commitments of an
14 organization and a Hazardous Waste Management ("HWM")
15 functional grouping provides for management of data elements
16 related to the organizations' generation of waste. Dynamic links
17 are maintained among all functional groupings that support the
18 real-time transfer of regulatory agency reporting due dates along
19 with progress toward meeting the reporting due dates. As a
20 consequence, the HCM grouping can be immediately updated with
21 compliance reporting completion information as soon as the final
22 version of the compliance report is run. The dynamic link
23 between the HWM and other groupings provides information on
24 the generation of waste as an output from the production process
25 as soon as the production process transaction is committed.
26 Execution of the waste generation transaction will trigger an

1 immediate update of the HWM grouping and will begin the
2 countdown of the 90 day RCRA calendar for wastes accumulated
3 on site without a permit. Sturgeon 10:39-60.

4 03. Sturgeon describes data blocks and fields that illustrate use of
5 the relational database schema to manage and track hazardous
6 substance-related information across all flows of paper, work
7 product, chemicals and complex data, for environmental, health,
8 and safety monitoring. Sturgeon presents exemplary computer
9 screen displays in FIGS. 5-45. Each of the computer screens for a
10 given function is optionally provided with a small block to
11 indicate whether the sequential position of the screen among
12 related screens. Sturgeon 23:60 – 24:40.

13 04. Sturgeon describes an Accidental Release Notification that
14 tracks all events related to a specific accident or other event and
15 records the circumstances that led to the accident. Sturgeon stores
16 a list of emergency response contacts as part of the emergency
17 response planning function and tracks the accident or other event,
18 as well as the XYZ response to the event. Sturgeon also produces
19 the follow-up Accidental Release Notification Report and
20 provides relevant protocols, before the fact, for responses to
21 unscheduled or excess releases of one or more hazardous
22 substances. Sturgeon 32:27-44.

23 *Santa Fe*

24 05. Santa Fe is a portion of the Santa Fe Pacific Corp. 1992 annual
25 report submitted to the SEC.

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1 Facts Related To Differences Between The Claimed Subject Matter And 2 The Prior Art

3 06. Neither reference describes nor suggests the remote computer
4 and its operations recited in claim 1 limitation [2].

5 Facts Related To The Level Of Skill In The Art

6 07. Neither the Examiner nor the Appellants has addressed the level
7 of ordinary skill in the pertinent arts of systems analysis and
8 programming, database management, or regulatory compliance
9 system design. We will therefore consider the cited prior art as
10 representative of the level of ordinary skill in the art. *See Okajima*
11 *v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he
12 absence of specific findings on the level of skill in the art does not
13 give rise to reversible error ‘where the prior art itself reflects an
14 appropriate level and a need for testimony is not shown’”)
15 (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755
16 F.2d 158, 163 (Fed. Cir. 1985)).

17 *Facts Related To Secondary Considerations*

18 08. There is no evidence on record of secondary considerations of
19 non-obviousness for our consideration.

21 PRINCIPLES OF LAW

22 *Anticipation*

23 "A claim is anticipated only if each and every element as set forth in the
24 claim is found, either expressly or inherently described, in a single prior art
25 reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628,
26 631 (Fed. Cir. 1987). "When a claim covers several structures or

1 compositions, either generically or as alternatives, the claim is deemed
2 anticipated if any of the structures or compositions within the scope of the
3 claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed.
4 Cir. 2001). "The identical invention must be shown in as complete detail as
5 is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d
6 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by
7 the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology
8 is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

9 *Obviousness*

10 A claimed invention is unpatentable if the differences between it and
11 the prior art are "such that the subject matter as a whole would have been
12 obvious at the time the invention was made to a person having ordinary skill
13 in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 550
14 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

15 In *Graham*, the Court held that the obviousness analysis is bottomed
16 on several basic factual inquiries: "[(1)] the scope and content of the prior art
17 are to be determined; [(2)] differences between the prior art and the claims at
18 issue are to be ascertained; and [(3)] the level of ordinary skill in the
19 pertinent art resolved." 383 U.S. at 17. *See also KSR*, 550 U.S. at 406.
20 "The combination of familiar elements according to known methods is likely
21 to be obvious when it does no more than yield predictable results." *Id.* at
22 416.

23

24

ANALYSIS

25 All four of the independent claims have limitations similar to those
26 argued by the Appellants regarding limitations [2] and [6] of claim 1. While

1 we find that the claim limitations that are performed by the remote computer
2 of accessing a remote program operative to display and modify only a
3 remote portion of the plurality of compliance events and only a remote
4 portion of the plurality of resources of the database fail to specify what the
5 limitation of “remote” is with respect to regarding the program, events, and
6 portion of resources, and so the program, events, and portion could indeed
7 be remote from the remote computer, this leaves the issue of the remote
8 computer itself unresolved.

9 The independent claims unambiguously require both a main and
10 remote computer. We are unable to discern any evidence of a remote
11 computer at the portions cited by the Examiner, or anywhere else in
12 Sturgeon. The portions cited by the Examiner describe exemplary screen
13 displays in a display attached to a computer (FF 03) and dynamic links
14 among the database elements (FF 02).

15 The Examiner provides no findings or explanation showing how these
16 portions would describe the required remote computer communicating with
17 the main computer. Thus, we find that Sturgeon fails to describe the remote
18 computer and its operations recited in claim 1 limitation [2] (FF 06) and the
19 Examiner erred in presenting a *prima facie* case of anticipation.

20 The Examiner has also not shown that the secondary reference Santa
21 Fe suggests this limitation, and we are unable to discern such a suggestion
22 (FF 06). Thus, we also find the Examiner erred in presenting a *prima facie*
23 case of obviousness as to claims 7-23 and 29-37. Because this limitation
24 requiring a remote computer is substantially present in all claims, the
25 Examiner’s error extends to rejections of all claims.

As to the argument regarding scheduling in limitation [6], we find that Sturgeon describes performing actions in response to certain stimuli (FF 04) and so the issue resolution hinges on the construction of the limitation “scheduling.” However, because we already found the Examiner failed to present a *prima facie* case, we need not reach this issue.

CONCLUSIONS OF LAW

8 The Appellants have sustained their burden of showing that the
9 Examiner erred in rejecting claims 1-6, 24-28, and 38-41 under 35 U.S.C. §
10 102(b) as anticipated by Sturgeon.

11 The Appellants have sustained their burden of showing that the
12 Examiner erred in rejecting claims 7-23 and 29-37 under 35 U.S.C. § 103(a)
13 as unpatentable over Sturgeon and Santa Fe.

DECISION

16 To summarize, our decision is as follows.

17 The rejection of claims 1-6, 24-28, and 38-41 under 35 U.S.C. §
18 102(b) as anticipated by Sturgeon is reversed.

19 The rejection of claims 7-23 and 29-37 under 35 U.S.C. § 103(a) as
20 unpatentable over Sturgeon and Santa Fe is reversed.

REVERSED

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Application 10/033,943

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